REMARKS

Claims 1, 14, 20, 26-30, and 33-35 are currently pending in the present application, with Claims 1, 14, and 20 being amended. Reconsideration and reexamination of the claims are respectfully requested.

The Examiner rejected Claims 1, 14, 20, 26-30 and 33-35 under 35 U.S.C. § 103(a) as being unpatentable over Ohomori (U.S. patent no. 6,477,315) in view of Weinstock et al. (U.S. Patent No. 6,166,314). This rejection is respectfully traversed with respect to the amended claims.

As previously communicated, the present invention is directed to a method for editing musical performance data using a computer system having a display. In particular, the present invention can be characterized in that a plurality of execution data (or articulation data) to be imparted into musical tones generated from performance data are respectively assigned to different graphically displayable layers, each of which is individually controllable to either be displayed or not be displayed. A user may, via a graphical user interface, attach an execution icon to the corresponding layer at a prescribed position for effecting editing of the performance data. For instance, a vibrato icon or a tremolo icon, both of which belong to the category pertaining to modulation, can be attached to the modulation icon layer (see L2 in Fig. 2 of the present application). By requiring the execution icons to be attachable only to the corresponding category layers, a user is prevented from possibly making mistakes by attaching an undesired icon accidentally.

As previously communicated, Weinstock is directed to an apparatus for correlating performance data onto a musical score, where the performance data is inputted in real time.

Ohomori, on the other hand, is directed to an editing graphical user interface for editing video. As the Examiner acknowledged, Ohomori does not teach or suggest editing music. As

the Examiner also apparently acknowledges, Ohomori does not disclose controlling whether to display each of the editing layers. However, the Examiner referred to Fig. 9 of Weinstock as teachings of controlling the display or non-display of editing layers. Applicants respectfully disagree. Applicants respectfully submit that Fig. 9 of Weinstock simply discloses controlling what to display on a computer screen, such as music title, volume, tempo, etc. Weinstock does not teach or suggest controlling the display or non-display of editing layers to which execution icons can be attached. In this regard, even when combined, Weinstock and Ohomori do not teach the combined invention.

Applicants further traverse the Examiner's combination of the two references. It is well settled patent law that hindsight cannot be used as motivation for combining prior art references. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1139 (Fed. Cir. 1985) (vacating judgment by trial court, noting it is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a "blueprint.") (citing Kalman v. Kimberly-Clark Group, 713 F.2d 760, 774 (Fed. Cir. 1983), cert denied 465 U.S. 1026 (1984)). Rather, there must exist some suggestion, teaching, or motivation, from one or both of the references, that would have led a person of ordinary skill in the art to combine the prior art references in a manner claimed. See Graham v. John Deere Co., 383 U.S. 1 (1966); In re Dembiczak, 175 F.3d 994, 998 (Fed. Cir. 1999). To do otherwise, "combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." Dembiczak, 175 F.3d at 999. In this regard, the Federal Circuit has consistently held that a person of ordinary skill in the art "must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner

claimed." Teleflex Inc. v. KSR Int'l Co., 119 Fed. Appx 282 (Fed. Cir. 2005) (citing In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000) ("Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.")).

In this instance, the Examiner at page 4 of the Detailed Action stated that it would have been obvious to one of ordinary skill in the art to:

> "make such a combination in order to provide an automated system for allowing users to track musical scores and performances; this combination also provides the advantage of allowing the user to correlate performance data with selected views of information that reduce screen clutter and optimizes the view according to the user's needs and preferences."

While the Examiner states advantages that the present application provides (and Applicants agree to the advantages), the Examiners fails to point to any motivation on either of Weinstock or Ohomori for such a combination. Indeed, the Primary Examiner appears to have used the claims as a foundational blueprint and, in hindsight, reconstructed the claimed invention by selectively combining the references.

Again, Applicants respectfully submit that the references, even when combined, do not teach or suggest selectively displaying editing layers to which corresponding execution icons may be attached at prescribed positions. Furthermore, Applicants traverse the Examiner's combination of the references for lack of demonstrated motivation. Accordingly, Applicants respectfully submit that the claims, as amended, are not obvious in view of Weinstock or Ohomori.

In view of the foregoing, Applicants respectfully submit that all of the pending claims are in condition for allowance.

Applicants respectfully request a telephonic interview with the Examiner. The Examiner is kindly requested to contact the undersigned attorney of record at (213) 892-5587 to discuss the content of this communication upon its receipt.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Deputy to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 393032019700.

Respectfully submitted,

Dated: April 5, 2006 By: _____

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